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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* KIRK D. SWENSON  
and JAMES C. SCHNEIDER

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Appeal 2010-010259  
Application 10/786,725  
Technology Center 3700

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Before DONALD E. ADAMS, JEFFREY N. FREDMAN, and STEPHEN WALSH, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 1-9 (App. Br. 5). We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

The claims are directed to a holder assembly. Claim 1 is representative and is reproduced in the “CLAIMS APPENDIX” of Appellants’ Brief (App. Br. 22).

Claims 1, 2, 5, 6, and 9 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of ‘311<sup>1</sup> and ‘842.<sup>2</sup>

Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of ‘311, ‘842, and Kobayashi.<sup>3</sup>

Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of ‘311, ‘842, and Newby.<sup>4</sup>

Claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of ‘311, ‘842, Newby, and Alesi.<sup>5</sup>

Claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of ‘311, ‘842, Kobayashi, and Alesi.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of ‘311, ‘842, and Gyure.<sup>6</sup>

We reverse.

*The combination of ‘311 and ‘842:*

ISSUE

Does the preponderance of evidence on this record support a conclusion of obviousness?

FACTUAL FINDINGS (FF)

FF 1. ‘311 suggests a needle assembly holder with rotatable safety sheath member (‘311, Title).

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<sup>1</sup> Hollister, US 5,277,311, issued January 11, 1994.

<sup>2</sup> Hollister, US 4,982,842, issued January 8, 1991.

<sup>3</sup> Kobayashi, US 6,695,819 B2, issued February 24, 2004.

<sup>4</sup> Newby et al., US 6,440,104 B1, issued August 27, 2002.

<sup>5</sup> Alesi et al., US 2003/0028152 A1, issued February 6, 2003.

<sup>6</sup> Gyure et al., US 5,681,295, issued October 28, 1997.

FF 2. For clarity ‘311’s Fig. 4 is reproduced below:

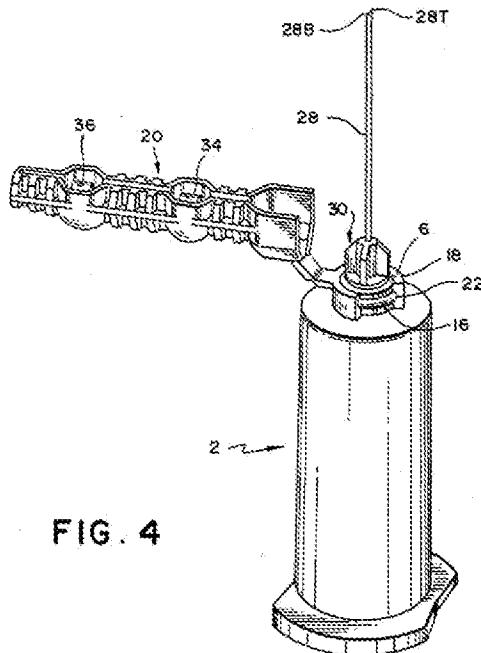


FIG. 4

“FIG. 4 is a perspective view of . . . [‘311’s] safety device . . . having mated thereto a needle assembly” (‘311, col. 2, ll. 53-55).

FF 3. ‘311’s holder housing 2 comprises a needle receiving port 6 for receiving a needle cannula 28 and an annular protrusion 16 that rotatably mates with groove 22 of collar 18 that is pivotably attached to safety shield 20, whereby the safety shield 20 and the collar 18 are axially rotatable with respect to the holder housing 2 about an axis of the holder housing 2 without axial movement of the collar along the axis (Ans. 3-4).

FF 4. ‘311 fails to suggest an annular skirt extending about the needle receiving port (Ans. 4).

FF 5. ‘842 suggests “[a] universal safety adapter which is usable with different types of needles and syringes” (‘842, Abstract).

FF 6. For clarity, '842's FIGs. 3 and 4 are reproduced below:

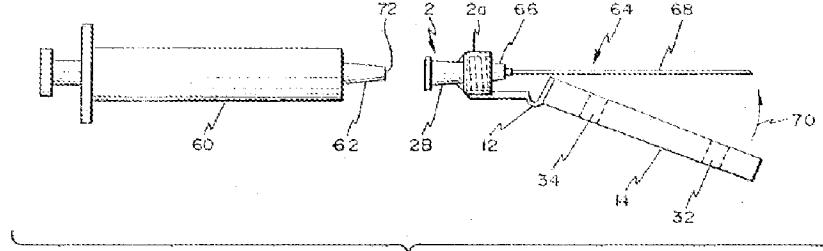


FIG. 3

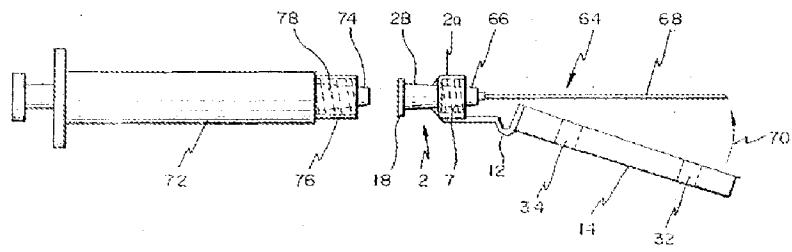


FIG. 4

"FIG. 3 is an overall view of the safety adapter of the present invention being used with a luer slip type syringe; and FIG. 4 is an overall view of the safety adapter of the present invention being used with a luer lock type syringe" ('842, col. 4, ll. 1-6).

FF 7. '842 suggests "a holder assembly wherein addition of an annular skirt 76 allows an annular protrusion 18 on a collar 2 to externally mate with a holder housing 72", as illustrated in '842's FIG. 4 (Ans. 5).

#### ANALYSIS

Based on the combination of '311 and '842, Examiner concludes that

it would have been obvious to one of ordinary skill in the art at the time Applicant's [sic] invention was made to provide the holder assembly of . . . ('311) with an annular skirt such that the

collar is received between the annular skirt and the receiving port of the holder housing as taught by . . . ('842).

(Ans. 5.) In this regard, Examiner explains

[W]hile Hollister ('311) teaches one way to attach a collar 18 to a housing 2 and housing end 6 (i.e. without an annular skirt) . . . ; Hollister ('842) teaches that one of ordinary skill in the art can alternately mate a collar 6 to a housing 72 or housing end 74 with or without the addition of an annular skirt 76.

(Ans. 14.)

*Claim 1:*

Appellants contend that “‘842 teaches a completely different device than that shown by . . . ‘311” (App. Br. 13; *Cf.* 2-3 and 6-7). In this regard, Appellants contend that

[T]he skirt taught by . . . ['842] teaches threads (78) along which the extension (18) moves in an axial direction with respect to the syringe. The incorporation of this type of skirt in . . . ['311] would necessarily result in axial movement of the collar and shield along the axis of the holder housing and eventually result in the disengagement of the shield and collar from the holder housing.

(Reply Br. 3 (emphasis removed).)

We recognize, but are not persuaded by, Examiner’s conclusion that a person of ordinary skill in this art could have modified the threaded skirt configuration of ‘842 with the “snap fit” arrangement of ‘311 and thereby obtain a configuration wherein a shield is attached between a needle cannula receiving port and an annular skirt in a manner that permits the shield to be rotated without movement along the axis of the holder housing (*see* Ans. 14-15). Examiner fails to establish an evidentiary basis on this record to support this conclusion.

Notwithstanding Examiner's assertion to the contrary, the preponderance of evidence on this record suggests attaching a shield to a housing by: (1) snap or slip fitting the shield to a housing in the absence of an annular skirt (FF 2 and 6 (Fig. 3)), which allows for rotation of the shield about the axis of the housing without movement along the axis of the housing or (2) threading the shield onto an annular skirt (FF 6 (Fig. 4)), wherein rotation of the shield results in movement of the shield along the axis of the housing. What is missing is a suggestion or reason to combine the snap-fit configuration of '311 with '842's annular shirt to arrive at a non-threaded annular skirt configuration that allows for the attachment of a shield in a manner that permits rotation of the shield about the housing without movement of the shield along the axis of the housing. In this regard, we are compelled to agree with Appellants' contention "that the suggestion or motivation for combining the references to achieve the present invention is gleaned through improper hindsight analysis involving Appellants' disclosure" (App. Br. 15).

#### CONCLUSION OF LAW

The preponderance of evidence on this record fails to support a conclusion of obviousness. The rejection of claims 1, 2, 5, 6, and 9 under 35 U.S.C. § 103(a) as unpatentable over the combination of '311 and '842 is reversed.

*The combination of '311, 842, and Kobayashi:*

#### ISSUE

Does the preponderance of evidence on this record support a conclusion of obviousness?

#### FACTUAL FINDINGS (FF)

FF 8. Examiner relies on ‘311 and ‘842 as discussed above (Ans. 6).

FF 9. The combination of ‘311 and ‘842 fails to suggest “a pivot assembly wherein a hanger bar is part of the safety shield and the hook arm is part of [the] collar” (*id.* (emphasis removed)).

FF 10. Kobayashi suggests “a holder assembly comprising a hanger bar . . . attached to a safety shield . . . and a hook arm . . . attached to a collar . . . such that the safety shield . . . pivots about the collar” (*id.*).

#### ANALYSIS

Appellants contend that “Kobayashi do[es] not rectify the basic deficiencies [in] the combination of Hollister ‘311 and Hollister ‘842 with respect to independent claim 1” (App. Br. 17). We agree.

#### CONCLUSION OF LAW

The preponderance of evidence on this record fails to support a conclusion of obviousness. The rejection of claims 3 and 4 under 35 U.S.C. § 103(a) as unpatentable over the combination of ‘311, ‘842, and Kobayashi is reversed.

*The combination of ‘311, ‘842, and Newby:*

#### ISSUE

Does the preponderance of evidence on this record support a conclusion of obviousness?

#### FACTUAL FINDINGS (FF)

FF 11. Examiner relies on ‘311 and ‘842 as discussed above (Ans. 6).

FF 12. The combination of ‘311 and ‘842 fails to suggest “a pivot assembly wherein a hanger bar is part of the safety shield and the hook arm is part of [the] collar” (*id.* (emphasis removed)).

FF 13. Newby suggests “a holder assembly comprising a hanger bar 182 attached to a safety shield 140 and a hook arm 114 attached to a collar 90 such that the safety shield 140 pivots about the collar 90” (Ans. 7).

## ANALYSIS

Appellants contend that “Newby do[es] not rectify the basic deficiencies [in] the combination of Hollister ‘311 and Hollister ‘842 with respect to independent claim 1” (App. Br. 18). We agree.

## CONCLUSION OF LAW

The preponderance of evidence on this record fails to support a conclusion of obviousness. The rejection of claims 3 and 4 under 35 U.S.C. § 103(a) as unpatentable over the combination of ‘311, ‘842, and Newby is reversed.

*The combination of ‘311, ‘842, Newby, and Alesi:*

## ISSUE

Does the preponderance of evidence on this record support a conclusion of obviousness?

## FACTUAL FINDINGS (FF)

FF 14. Examiner relies on ‘311, ‘842, and Newby as discussed above (Ans. 7).

FF 15. The combination of ‘311, ‘842, and Newby fails to suggest “a holder assembly wherein the annular skirt on the holder housing substantially encloses an open end of the hook arm” (*id.* (emphasis removed)).

FF 16. Examiner relies on Alesi to suggest “that it is known to provide a living hinge attached to the annular skirt . . . of the holder housing” (*id.*).

## ANALYSIS

Appellants contend that “Newby and/or Alesi do not rectify the basic deficiencies in the combination of Hollister ‘311 and Hollister ‘842 with respect to independent claim 1” (App. Br. 19). We agree.

## CONCLUSION OF LAW

The preponderance of evidence on this record fails to support a conclusion of obviousness. The rejection of claim 7 under 35 U.S.C. § 103(a) as unpatentable over the combination of ‘311, ‘842, Newby, and Alesi is reversed.

*The combination of ‘311, ‘842, Kobayashi, and Alesi:*

## ISSUE

Does the preponderance of evidence on this record support a conclusion of obviousness?

## FACTUAL FINDINGS (FF)

FF 17. Examiner relies on ‘311, ‘842, and Kobayashi as discussed above (Ans. 8).

FF 18. The combination of ‘311, ‘842, and Kobayashi fails to suggest “a holder assembly wherein the annular skirt on the holder housing substantially encloses an open end of the hook arm” (*id.* (emphasis removed)).

FF 19. Examiner relies on Alesi to suggest “that it is known to provide a living hinge attached to the annular skirt . . . of the holder housing” (*id.*).

## ANALYSIS

Appellants contend that “Kobayashi and/or Alesi do not rectify the basic deficiencies in the combination of Hollister ‘311 and Hollister ‘842 with respect to independent claim 1” (App. Br. 20). We agree.

## CONCLUSION OF LAW

The preponderance of evidence on this record fails to support a conclusion of obviousness. The rejection of claim 7 under 35 U.S.C. § 103(a) as unpatentable over the combination of ‘311, ‘842, Kobayashi, and Alesi is reversed.

*The combination of ‘311, ‘842, and Gyure:*

## ISSUE

Does the preponderance of evidence on this record support a conclusion of obviousness?

## FACTUAL FINDINGS (FF)

- FF 20. Examiner relies on ‘311 and ‘842 as discussed above (Ans. 9).
- FF 21. The combination of ‘311 and ‘842 fails to suggest “a collar having one or more slits in a rearward portion thereof” (*id.* (emphasis removed)).
- FF 22. Examiner relies on Gyure to suggest “a holder assembly comprising a collar having one or more slits in a rearward portion thereof” (*id.*).

## ANALYSIS

Appellants contend that “Gyure do[es] not rectify the basic deficiencies [in] the combination of Hollister ‘311 and Hollister ‘842 with respect to independent claim 1” (App. Br. 21). We agree.

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#### CONCLUSION OF LAW

The preponderance of evidence on this record fails to support a conclusion of obviousness. The rejection of claim 8 under 35 U.S.C. § 103(a) as unpatentable over the combination of '311, '842, and Gyure is reversed.

REVERSED

alw